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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,538	09/19/2003	Bradley Berman	KING.005C1	5905
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Hollingsworth & Funk, LLC				
Suite 125				
8009 34th Avenue South				
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		EXAMINER		
		HSU, RYAN		
		ART UNIT		PAPER NUMBER
		3714		

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,538

Applicant(s)

BERMAN ET AL.

Examiner

Ryan Hsu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/09/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A dependent claim may not be dependent upon itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 4-23 are rejected under 35 U.S.C. 102(b) as being anticipated by
Telnaes (US 4,448,419).**

Regarding claim 1, Telnaes discloses a method of facilitating participation in a slot game comprising: presenting a mechanical reel configuration comprising a plurality of active reel segments (*see Figs. 1 and 2 and the respective related description thereof*). Additionally, Telnaes discloses presenting symbols in each of the active reel segments (*ie: physical symbols on*

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the mechanical reel) (see symbols [14] of Fig. 3 and the related description thereof). In Telnaes' gaming machine the system allows for virtual reel stops that are activated and deactivated based on the random number readout (see col. 4: ln 41-col. 5: ln 4). This enables several virtual positions to be activated and deactivated resulting and affecting the physical symbol read out and the stopping positions of the physical reels. Telnaes' also allows for repeatedly presenting symbols in each of the active reel segments and deactivating the active reel segments associated with the discontinue symbols, until a predetermined number of active reel segments have been deactivated (*ie: the system will continue to rotate through the mechanical reels until they are brought to a stop (deactivated) in the display grid*) (see col. 4: ln 19-40).

Regarding claims 4-6, Telnaes discloses a system where at least partially randomly selecting which symbol is to be presented in each of the active reel segments (see col. 3: ln 1-17). Additionally, Telnaes teaches a game system where the symbol is presented comprises associated a reel strip having a predetermined symbol set to each of the active reel segments (see col. 4: ln 40-68). Furthermore, Telnaes teaches a game system wherein associating a reel strip having a predetermined symbol set to each of the active reel segments comprises associating a different reel strip to each of the active reel segments (*virtual reel [50] of Fig. 6 and the related description thereof*).

Regarding claims 7-8, Telnaes discloses a system wherein at least partially randomly selecting which symbol is to be presented comprises associating a predetermined symbol set to a plurality of the active reel segments (see Fig. 6 and the related description thereof).

Regarding claims 9-10, Telnaes discloses a method wherein at the active reel segments that are deactivated by being associated with a discontinue symbol are de-emphasized to be distinguished from the active reel segments (*see Fig. 6 and the related description thereof*).

Regarding claims 11-15, Telnaes discloses a method wherein presenting symbols in each of the active reel segments comprises presenting continue symbols in one or more of the active reel segments, wherein the continue symbols direct its respective one of the active reel segments to remain active. Additionally, the method comprises associated a credit award with one or more of the continue symbols and implementing a credit award with one or more of the continue symbols. Furthermore, the credit award may have a positive, negative or null effect on an accumulated credit total (*ie: win or lose credit award of wager lost or gained based on predetermined payout scheme*) (*see col. 4: ln 55-col. 5: ln 31*).

Regarding claims 16-19, Telnaes discloses a method comprising associating a credit award with one or more of the discontinue symbols. Where the discontinue symbols may have an additive effect a negative effect or a null effect on an accumulated credit total (*ie: win or lose credit award of wager lost or gained based on predetermined payout scheme*) (*see col. 4: ln 55-col. 5: ln 31*).

Regarding claims 20-23, Telnaes discloses a method wherein repeatedly presenting symbols comprises automatically repeating presenting symbols and deactivating the active reel segments until all of the active reel segments have been deactivated (*see reel and pay line*

process, col. 3: ln 42-col. 4: ln 68). Additionally, the repeated presenting symbols comprise of providing a user interface to allow a participant to initiate each repeated presentation of symbols until all of the active reel segments have been deactivated (*see col. 3: ln 1-17*). Furthermore, the repeated presentation of symbols and deactivating the active reel segments until a predetermined number of the active reel segments have been deactivated comprises deactivating the active reel segments until all of the active reel segments have been deactivated (*see rotation of reels, col. 4: ln 19-40*).

Claims 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (US 5,722,891).

Regarding claims 34, Inoue discloses a casino gaming apparatus hosting a gaming activity having at least a standard mode of operation and a bonus mode of operation (*see abstract*), the casino gaming apparatus comprising: a first reel configuration to display a plurality of display cells (*see mechanical reels [5b, 5b, 5c] of Fig. 1 and the related description thereof*); a user interface to facilitate player participation in at least the standard mode of operation; and a processor configured to identify a predetermined symbol combination occurring on the first reel configuration during the standard mode of operation to activate the bonus mode of operation, and during the bonus mode of operation to randomly present symbols via a second reel configuration which includes one or more reels having corresponding reel strips, to deactivate the reels presenting a discontinue symbol, and to repeat the random presentation of symbols and deactivation of the reels have been deactivated (*see bonus reels [6a, 6b, 6c] of Fig. 1 and the related description thereof*).

Regarding claim 35, Inoue discloses a method for facilitating participation in a slot game, comprising: presenting a display grid comprising a plurality of active display segments; presenting symbols in each of the active display segments (*ie: active paylines, see display [2] of Fig. 1 and the related description thereof*); deactivating the active display segments that are associated with a discontinue symbol, and repeatedly presenting symbols in each of the active display segments, and deactivating the active display segments associated with the discontinue symbols, until a predetermined number of the active display segments have been deactivated (*ie: until stop reels is hit*) (*see col. 3: ln 50-67, col. 5: ln 35-52*).

Claims 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayeroff (US 6,186,894 B1).

Regarding claim 24, Mayeroff discloses a casino gaming apparatus hosting a gaming activity having at least a standard mode of operation and a bonus mode of operation, the casino gaming apparatus comprising: a video screen to present a display grid having a plurality of display cells (*see multiple pay line grid [21] of Fig. 1 and the related description thereof*); a user interface to facilitate player participation in at least the standard mode of operation (*see col. 5: ln 15-47*); and a processor configured to identify a predetermined symbol combination occurring on the display grid during the standard mode of operation to activate the bonus mode of operation, and during the standard mode of operation to activate the bonus mode of operation, and during the bonus mode of operation to randomly present symbols via a physical reel configuration which includes one or more reels having corresponding reel strips, to deactivate the reels

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presenting a discontinue symbol, and to repeat the random presentation of symbols and deactivation of the reels associated with the discontinue symbols until a predetermined number of the reels have been deactivated (*see col. 4: ln 29-col. 6: ln 54*).

Regarding claims 25-28, Mayeroff discloses a system wherein the processor comprises a random number generator configured to randomly select the symbols for presentation via the reels. Additionally, the system implements a user interface mechanism to allow the player to initiate each repetition of the random presentation of symbols (*see col. 1: ln 10-54*). Mayeroff also discloses a bonus payout bar to present payout subtotals for each of the reels associated with the bonus mode of operation (*see Table 2 and 3 of col. 7-8 and Fig. 1 and the related description thereof*). Furthermore, the processor is configured to automatically repeat the random presentation of symbols and deactivation of the reels associated with the discontinue symbols until all of the active display reels have been deactivated without player intervention (*see col. 4: ln 35-col. 5: ln 47*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tenaes (US 4,448,419) in view of Inoue (US 5,722,891).

Regarding claims 2-3, Tenaes teaches a game machine wherein presenting a mechanical reel configuration comprising a plurality of active reel segments comprises presenting the active reel segments (*see Fig. 6 and the related description thereof*). However he is silent with regards to implementing a bonus mode of play in response to presentation of a symbol combination during a standard mode of play that invokes the bonus mode of play and a bonus symbol set comprising the symbols presented in each of the active reel segments during the bonus mode of play is different than a standard symbol set comprising standard symbols presented in the mechanical reel configuration during the standard mode of play. However in an analogous game machine Inoue teaches the implementation of a secondary reel set that implements a bonus mode of play where the bonus symbol set comprises symbols that are presented in active reel segments during the bonus mode of play that is different from the standard symbol set (*see bonus reels [6a, 6b, 6c] of Fig. 1 and the related description thereof*). Inoue teaches that one would be motivated to implement this feature into a game machine in order to provide a more exciting experience and also allow for an additional incentive to the player in order to increase their

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winnings. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement the bonus game into the virtual reel system of Telnaes to create a more exciting game machine.

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff in view of Marnell, II et al. (US 5,332,219).

Regarding claims 29-32, Mayeroff teaches a gaming machine wherein the casino gaming apparatus comprises a slot machine and the standard mode of operation of the slot machine is a slot game (*see slot machine of Fig. 1 and the related description thereof*). However, Mayeroff is silent with regard to its implementation of a basic game including a poker game, bingo game, or keno game.

In a related patent, Marnell, II et al. teaches that it has become well known in the art that electronic gaming machines may be devised for playing games such as “roulette, keno, poker, bingo, lotto and the like” (*see col. 1: ln 13-20*). One would be motivated to implement these games to offer a wider variety of games thus attracting more players. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement poker, bingo, or keno as a base game for the machine taught by Mayeroff.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff as applied to claims above, and further in view of Inoue (US 5,722,891).

Regarding claim 33, Mayeroff teaches a gaming machine wherein the random presentation of symbols and the deactivation of reels occur through the spinning and stopping of

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the reels (*see col. 5: ln 10-25, col. 6: ln 5-67*). However, Mayeroff is silent with regards to a processor configuring to repeat the process to randomly present the symbols and deactivation of the reels associated with the discontinue symbols until all of the reels have been deactivated. However in a related patent, Inoue teaches the use of a processor which controls the reels in order to randomly present the symbols and deactivate the reels associated with discontinue symbols until all the reels have been deactivated (*ie: reels have come to a stop*) (*see driver [21c], and MPU [25] of Fig. 2 and the related description thereof*). The teachings of Inoue simply show how the electrical components can control the mechanical reels. One would be motivated to implement this feature in order to accurately control the movement of the reels. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement the processor of Inoue into the slot machine of Mayeroff.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gura (US 6,159,097) – Gaming Machine with Variable Probability of Obtaining Bonus Game Payouts.

Slomiany et al. (US 6,648,757 B1) – Dual-Award Bonus Game For A Gaming Machine.

Adams (US 5,823,874) – Method of Playing a Game Machine With an Additional Payout Indicator.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

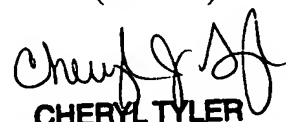
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J Tyler can be reached at (571)-272-4834.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).



RH



CHERYL TYLER
SUPERVISORY PATENT EXAMINER

December 11, 2005